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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/715,463	11/19/2003	Blake Bookstaff	60557.000007	3755

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EXAMINER

CHARLES, DEBRA F

ART UNIT PAPER NUMBER

3628

DATE MAILED: 10/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/715,463

Applicant(s)

BOOKSTAFF ET AL.

Examiner

Debra F. Charles

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-13 are rejected under 35 U.S.C. 101 because the bodies of the claims do not recite technology, i.e. computer implementation or any other technology in a non-trivial manner. *In re Toma*, 197 USPQ 852 (CCPA 1978). *Ex parte Bowman* 61 USPQ2D 1669.

For a claim to be statutory under 35 USC 101 the following two conditions must be met:

1) The claimed invention must produce a “useful, concrete, tangible result” (*In re Alappat*, 31USPQ2d 1545, 1558 (Fed. Cir. 1994) and *State Street vs. Financial Signature Group Inc.*, 47 USPQ2d 1596’ 1601-02 (Fed Cir. 1998));

AND

2) The claimed invention must utilize technology in a non-trivial manner (*Ex parte Bowman*, 61 USPQ2d 1665, 1671 (Bd. Pat. Pat. App. & Inter. 2001)).

As to the technology requirement, note MPEP 2106 IV B 2(b). Also note *In re Waldbaum*, 173USPQ 430 (CCPA 1972) which teaches "useful arts" is synonymous with "technological arts". In *Musgrave*, 167USPQ 280 (CCPA 1970), *In re Johnston*, 183USPQ 172 (CCPA 1974), and *In re Toma*, 197USPQ 852 (CCPA 1978), all teach a technological requirement.

In *State Street*, "in the technological arts" was never an issue. The invention in the body of the claim must recite technology. If the invention in the body of the claim is not tied to technological art, environment, or machine, the claim is not statutory. *Ex parte Bowman* 61USPQ2d 1665,1671 (BD. Pat. App. & Inter.2001)(Unpublished).

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1,2,4, 5,6, 7, 9, 10 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Provost(U.S.PAT 6760707 B2), King et al.(U.S.PUB. 2002/0091827 A1), and Hagan (U.S.PAT. 6415267 B1).

Re claims 1 and 9: Provost disclose a method for registering a domain name comprising:

receiving a registration payment from a customer(col. 4, lines 5-33);

Provost disclose(s) the claimed invention except registering a domain name specified by the customer with a domain name registry for a first registration period; and registering the domain name with the domain name registry for at least a second registration period. However, in page 4, para. 0045-0048 thereof, King et al. disclose(s) domain name registration for set periods. It would be obvious to one of ordinary skill in the art to modify the invention of Provost based on the teachings of King et al. The motivation to combine these references is to extend the invention of Provost to effectively determine domain registration periods.

Provost and King et al. disclose(s) the claimed invention except investing at least a portion of the registration payment; using at least a portion of a return on the investment of at least a portion of the registration payment funds as payment to the domain name registry; and least a portion of the registration payment is used as payment. However, in Abstract, col. 1, line 60 – col. 2, line 40 thereof, Hagan disclose(s) investing funds to generate income to pay a specific commitment. It would be obvious to one of ordinary skill in the art to modify the invention of Provost and King et al. based on the teachings of Hagan. The motivation to combine these references is to facilitate continued payment of commitments by generating a stream of income from the initial principal payments.

Re claims 4, 5 and 10: Provost and King et al. disclose(s) the claimed invention except at least a portion of the return on the investment is reinvested, and at least a portion of the return on the investment is disbursed as profit. However, in Abstract, col. 1, line 60 – col. 2, line 40 thereof, Hagan disclose(s) investing funds to generate income to pay a specific commitment and certain funds are distributed based on certain set conditions. It would be obvious to one of ordinary skill in the art to modify the invention of Provost and King et al. based on the teachings of Hagan. The motivation to combine these references is to facilitate continued payment of commitments by generating a stream of income from the initial principal payments.

Re claim 6. Provost disclose further comprising advertising via a third party(Abstract, col. 2, lines 40-60).

Re claims 7 and 11: Provost and King et al. disclose(s) the claimed invention except at least a portion of the registration payment is invested in one of a group consisting of: a stock; a bond; a mutual fund; a certificate of deposit (CD); an annuity; a perpetuity; a precious metal; a real estate holding; a real estate investment trust (REIT) and a venture capital investment. However, in Abstract, col. 1, line 60 – col. 2, line 40, col. 5, lines 1-25 thereof, Hagan disclose(s) investing funds to generate income to pay a specific commitment and certain funds are distributed based on certain set conditions, and invested in various different types of investments. It would be obvious to one of ordinary skill in the art to modify the invention of Provost and King et al. based on the teachings of Hagan. The motivation to combine these references is to facilitate continued payment of commitments by generating a stream of income from the initial principal payments.

4. Claims 3 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Provost, King et al., and Hagan as applied to claims 1 and 9 above, and further in view of Singhal et al.(U.S.PAT. 6633761 B1).

Re claims 3 and 12: Provost, King et al., and Hagan disclose(s) the claimed invention except the first registration period and the second registration period each are not more than a maximum registration period allowed by the domain name registry, and wherein a sum of the first registration period and the second registration period is greater than the maximum registration period; the continuous series of registration periods is perpetual.

However, in col. 5, lines 55-col. 7, line 20 thereof, Singhal et al. disclose(s) time periods for valid registrations that vary under different conditions. It would be obvious to one of ordinary skill in the art to modify the invention of Provost, King et al., and Hagan based on the teachings of Singhal et al. The motivation to combine these references is the varying registration periods discussed parallels the registration period variations in the invention.

Allowable Subject Matter

5. Claims 8 and 13 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Vande Pol, (U.S.PUB. 2003/0014342A1) which discloses an environmental management system with an insured certification process standard.

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Brown, (U.S.PUB. 2002/0010795 A1) which discloses a method and system for protecting domain names.

Halpern,(U.S.PAT. 6332132 B1) which discloses automated methods and apparatus for programmed periodic replenishment of principal with annual adjustment to future interest rates.

Prakash et al., Old Wine in a New Bottle: Growth Opportunities and re-pouring of Gordon's Vintage Dividend Policy.

Danielson, Morris G., A Simple Valuation Model and Growth Expectations.

Chance et al., The New Science of Finance.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Debra F. Charles whose telephone number is (703) 305-4718. The examiner can normally be reached on 9-5 Monday thru Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hyung S. Sough can be reached on (703) 308-0505. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Debra F. Charles

Examiner

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